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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,812	11/25/2003	Leslie F. Warren JR.	024.0055	9757
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INGRASSIA FISHER & LORENZ, P.C. 7150 E. CAMELBACK, STE. 325 SCOTTSDALE, AZ 85251				
			EXAMINER FEELY, MICHAEL J	
			ART UNIT 1712	PAPER NUMBER

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/723,812	<b>Applicant(s)</b> WARREN ET AL.	
	<b>Examiner</b> Michael J. Feely	<b>Art Unit</b> 1712	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 22 and 26-59 is/are pending in the application.  
     4a) Of the above claim(s) 1-10 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38-55 is/are allowed.
- 6) ☒ Claim(s) 22, 26-37 and 56-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Pending Claims***

Claims 1-10, 22, and 26-59 are pending; claims 1-10 are withdrawn.

### ***Previous Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. The rejection of claims 14-18 under 35 U.S.C. 112, second paragraph, has been rendered moot by the cancellation of these claims.
3. The rejection of claims 26-30, 35, 37, 41-44, 49, and 51 under 35 U.S.C. 112, second paragraph, has been overcome by amendment.

### ***Previous Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The rejection of claims 11-21 and 23-25 under 35 U.S.C. 103(a) as being unpatentable over Ryang et al. (US Pat. No. 5,962,608) in view of Mehring et al. (New Sol-Gel Routes to Organic-Inorganic Hybrid Materials: Modification of Metal Alkoxide by Phosphonic or Phosphinic Acids) has been rendered moot by the cancellation of these claims.

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6. The rejection of claims 38-51 under 35 U.S.C. 103(a) as being unpatentable over Ryang et al. (US Pat. No. 5,962,608) in view of Mehring et al. (New Sol-Gel Routes to Organic-Inorganic Hybrid Materials: Modification of Metal Alkoxide by Phosphonic or Phosphinic Acids) has been withdrawn.

7. The rejection of claims 22 and 26-37 under 35 U.S.C. 103(a) as being unpatentable over Ryang et al. (US Pat. No. 5,962,608) in view of Mehring et al. (New Sol-Gel Routes to Organic-Inorganic Hybrid Materials: Modification of Metal Alkoxide by Phosphonic or Phosphinic Acids) stands.

8. Furthermore, new claims 56-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryang et al. (US Pat. No. 5,962,608) in view of Mehring et al. (New Sol-Gel Routes to Organic-Inorganic Hybrid Materials: Modification of Metal Alkoxide by Phosphonic or Phosphinic Acids).

Regarding claims 22 and 26-37, Ryang et al. disclose: (22) a process for making a polymer composition comprising the steps of:

- contacting a metal oxide precursor with a *multifunctional compound* to form a chelated metal oxide precursor (Abstract; column 22, lines 38-47);
- at least partially hydrolyzing said chelated metal oxide precursor to form at least partially hydrolyzed chelated metal oxide precursor monomers (Abstract; column 22, lines 38-47);
- permitting said at least partially hydrolyzed chelated metal oxide precursor monomers to polycondense to form a metal oxide sol, *the sol comprising a liquid phase and a disperse phase, the disperse phase comprising nano-clusters having an average size of less than*

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*about 1000 nm, the nano-clusters comprising metal oxide* (Abstract; column 22, lines 23-47);

- contacting at least the dispersed phase of said metal oxide sol with a polymer material to form a mixture (Abstract; column 30, lines 20-37); and
- producing a polymer composition dispersed therein, from the mixture (Abstract; column 30, lines 20-37);

(26) wherein the step of contacting a metal oxide precursor with a *multifunctional compound* comprises selecting said metal oxide precursor from the group consisting of a transition metal, an alkaline earth metal and a metallic element selected from the group 3A, 4A, and 5A of the periodic table of elements (column 23, lines 17-30); (27) wherein the step of selecting said metal oxide precursor comprises selecting said metal oxide precursor from the group of metal oxide precursors consisting of aluminum, antimony, bismuth, calcium, chromium, magnesium, tin, titanium, zinc, and zirconium (column 23, lines 17-23);

(28) further comprising, before the step of at least one polymerizing and solidifying said mixture, the step of contacting said mixture with at least one ingredient selected from *see claim for list* (column 30, lines 14-19);

(29) further comprising, before the step of contacting said metal oxide sol with at least one ingredient selected from *see claim for list* (column 30, lines 14-19);

(33) wherein the step of at least partially hydrolyzing said chelated metal oxide precursor comprising the step of contacting said chelated metal oxide with a hydrolyzing agent (Abstract; column 22, lines 38-47); (34) wherein the step of at least partially hydrolyzing said chelated

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metal oxide precursor comprises the step of contacting said chelated metal oxide with de-ionized water (Abstract; column 22, lines 38-47; column 26, lines 58-60);

(35) wherein the step of contacting at least the dispersed phase of said metal oxide sol with a polymer material comprises contacting said metal oxide sol with a polymer material selected from *see claim for list* (column 3, lines 39-53);

(36) further comprising the step of contacting said metal oxide precursor with a solvent before the step of contacting said metal oxide precursor with a *multifunctional compound* (column 22, lines 38-47; column 25, lines 56-67); and (37) wherein the step of contacting said metal oxide precursor with a solvent comprises the step of selecting said solvent from the group consisting of water, alcohols, and glycols (column 22, lines 38-47; column 25, lines 56-67).

Regarding claims 56-59, Ryang et al. disclose: (56) a process for making a polymer composition, the process comprising the steps of:

- contacting a metal oxide precursor with a *multifunctional compound* to form a chelated metal oxide precursor (Abstract; column 22, lines 38-47);
- at least partially hydrolyzing said chelated metal oxide precursor to form at least partially hydrolyzed chelated metal oxide precursor monomers (Abstract; column 22, lines 38-47);
- permitting said at least partially hydrolyzed chelated metal oxide precursor monomers to polycondense to form a metal oxide sol (Abstract; column 22, lines 23-47);
- contacting at least the dispersed phase of said metal oxide sol with a polymer material to form a mixture (Abstract; column 30, lines 20-37); and

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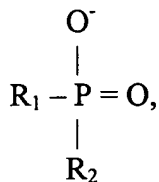
- producing a polymer composition comprising *from about 0.5 to about 30 wt% metal oxide dispersed therein* (Abstract; column 29, line 61 through column 30, line 14), *the metal oxide in nano-clusters having an average size less than about 1000 nm* (Abstract; column 22, lines 23-47);

(57) wherein the nano-cluster average size is less than about 100 nm (Abstract; column 22, lines 23-47); and (58 & 59) wherein the concentration of the metal oxide is from about 0.1 to about 10 wt% (column 29, line 61 through column 30, line 14).

With respect to all of the above claims, Ryang et al. disclose: “The *multifunctional compound* is *any compound capable of coordinating to a metal oxide precursor through a chelating functional group*. The multifunctional compound which is contacted with the metal oxide precursors contains at least one react-able functional group and at least one chelating functional group. The chelating functional groups generally coordinate through nitrogen, oxygen, sulfur, *phosphorus*, arsenic and/or selenium atoms; thus chelating functional groups contain at least one of N, O, S, *P*, As and Se atoms. Chelating functional groups include...*phosphonic acids*...The chelating functional groups coordinate to (react with) the metal of the metal oxide precursor in such a way to form a coordinated or chelated metal oxide complex that can prevent gelation of the sol by retarding, preventing or partially preventing hydrolysis and/or condensation,” (column 24, lines 6-25).

However, they fail to explicitly disclose: (22 & 56) a source of organophosphinate anions to form a phosphinate-chelated metal oxide precursor; (30) wherein said source of organophosphinate anions has the formula:

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wherein R<sub>1</sub> and R<sub>2</sub> are selected from the group of moieties consisting of an alkyl, an aryl, an alkoxy and an aryloxy moiety; (31) wherein said source of organophosphinate anions is a phosphinic acid; and (32) wherein said phosphinic acid is a diphenylphosphinic acid.

Mehring et al. disclose a two-step sol-gel route to form organic-inorganic hybrid materials by modifying metal alkoxide with phosphonic or phosphinic acid (Abstract). The process involves a non-hydrolytic condensation between phenylphosphonic acid (PPA) or diphenylphosphinic acid (DPPA) and a metal alkoxide. This reaction product is then subjected to hydrolysis/condensation of the remaining alkoxide groups (page 100, column 2). In conclusion, Mehring et al. state that since there is not removal of the PPA or DPPA ligands upon hydrolysis, these modified metal alkoxides appear to be well suited for the synthesis of new hybrid materials (page 102, column 1).

One of ordinary skill in the art would have recognized that the modified metal oxides of Mehring et al. fit the non-limited description set forth in Ryang et al. Mehring et al. also explicitly state that these materials appear to be well suited for the synthesis of new hybrid materials. *Furthermore, one of ordinary skill in the art would have recognized that the chemical nature of these materials would have inherently provided some flame-retardant properties to these hybrid materials due to the presence of phosphorus.* Lastly, it has been found that the selection of a known material based on its suitability for intended use supports a *prima facie* obviousness determination – see MPEP 2144.07.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a source of organophosphinate anions (*including diphenylphosphinic acid*) to form a phosphinate-chelated metal oxide precursor, as taught by Mehring et al., in the process of Ryang et al. because the modified metal oxides of Mehring et al. fit the non-limited description set forth in Ryang et al., and Mehring et al. explicitly state that these materials appear to be well suited for the synthesis of new hybrid materials.

### ***Response to Arguments***

9. Applicant's arguments, see pages 18-19 of the response, filed July 31, 2006, with respect to claim 38 and new claim 52 have been fully considered and are persuasive. The prior art rejection of claims 38-51 has been withdrawn.

The Examiner agrees that the combined references fail to teach or suggest the step of contacting the phosphinate-chelated metal oxide *precursor* with the polymer material, prior to the at least partial hydrolysis of the precursor.

10. Applicant's arguments, see pages 18-19 of the response, filed July 31, 2006, with respect to claim 22 and new claim 56 have been fully considered but they are not persuasive.

Applicant argues that, "While Ryang suggests some *micro-cluster* sizes, these are well below 1000 nm and in the *less than* 10, 5, and 2 nm range, and would not suggest sizes like 200 nm, which are yet *less than 1000 nm*." Applicant is reminded that their claims set forth an open ended range of less than about 1000 nm, which certainly does encompass the particle sizes set forth in Ryang et al. – *see MPEP 2131.03 & 2144.05* It is the Examiner's stance that one skilled in the art would have clearly envisaged *less than about 1000 nm* to include materials less than

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10, 5, and 2 nm. At the very least, the claimed range is *prima facie* obvious in light of the particle sizes set forth in Ryang et al.

Applicant also asserts that the composition would not have been flame resistant. As set forth in the prior art rejection, it is the Examiner's position that *one of ordinary skill in the art would have recognized that the chemical nature of these materials would have inherently provided some flame-retardant properties to these hybrid materials due to the presence of phosphorus*. Furthermore, it has been found that, "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present – *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) (*see MPEP 2112.01*).

***Allowable Subject Matter***

11. Claims 38-55 are allowed.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

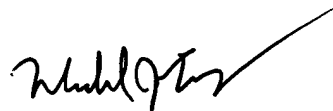
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Communication***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Feely whose telephone number is 571-272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Michael J. Feely  
Primary Examiner  
Art Unit 1712

October 13, 2006

**MICHAEL FEELY  
PRIMARY EXAMINER**